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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/874,856
Applicant(s) : SCOTT et al.
Filed : June 5, 2001
Title : Film Forming Cosmetic Compositions

TC/A.U. : 1617
Examiner : Gina C. Yu
Conf. No. : 5088
Docket No. : 8579

APPEAL BRIEF

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

This Appeal Brief is submitted in support of the Notice of Appeal filed on June 26, 2003, received June 30, 2003, setting a two-month period for response. Since August 30th fell on a Saturday and Monday, September 1st was a national holiday, Appellants believe this brief to be timely pursuant to 37 CFR §1.7.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio. The Inventors Alic Anthony Scott, John Michael Gilley and Craig Eugene Zoltowski assigned their interest to The Procter & Gamble Company which was recorded on August 14, 2001, reel 12089, frame 382.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellants, or known to

Appellants' legal representative that will directly affect, will be directly affected by, or will have a bearing on the Board's decision in the present appeal.

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STATUS OF CLAIMS

Claims 1-4 and 6-25 are pending and stand rejected. A copy of these claims, which are being appealed, appear in Appendix I.

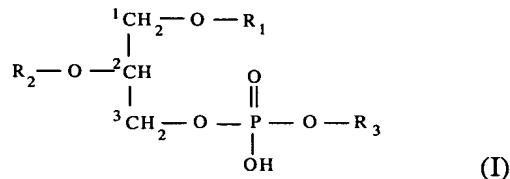
STATUS OF AMENDMENTS

No amendments were submitted by Appellants subsequent to the final Official Action.

SUMMARY OF THE INVENTION

The present invention relates to cosmetic compositions having improved application benefits to keratinous tissue and keratinous fibers wherein said compositions have improved application benefits, while avoiding the negatives associated with compositions currently known in the art. The compositions of the present invention can comprise the following components either before or after mixing:

- a. from about 0.1% to about 5% of a phospholipid having the formula



in which R₁ represent C₁₀₋₂₀ acyl, R₂ represent hydrogen or C₁₀₋₂₀ acyl, R₃ represent hydrogen, 2-trimethylamino-1-ethyl, 2-amino-1-ethyl, C₁₋₄ alkyl, C₁₋₅ alkyl substituted by carboxy, C₂₋₅ alkyl substituted by hydroxy, C₂₋₅ alkyl substituted by carboxy and hydroxy or C₂₋₅ alkyl substituted by carboxy and amino, the inositol group or the glyceryl group, or salts of these compounds;

- b. from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and
- c. from about 0.1% to about 30%, by weight of the composition, of at least one resin.

ISSUES

Appellants present the following issue for consideration on appeal:

- I. Under 35 USC §103, do the general disclosures of the cited references provide a skilled artisan with the motivation necessary to arrive at Appellants' claimed cosmetic composition when the reference fails to teach or suggest the necessity of the claimed amount of Appellants' specific PVP copolymers in combination with Appellants' claimed range of lecithin and resin?

GROUPING OF CLAIMS

Claims 1-4 and 6-25 stand or fall together.

ARGUMENTS

In the Office Action dated December 27, 2002, the Examiner rejected Claims 1-4 and 6-25 under 35 USC §103(a) as being unpatentable over Bartholomey et al., US 5614200 (hereinafter "Bartholomey") in view of Snyder et al., US 5389363 (hereinafter "Snyder"). The Examiner reasoned that Bartholomey teaches mascara compositions comprising lecithin (Phospholipon 80), which meets the limitations of instant claim 1(a) and 2-4; and ammonia acrylate copolymer (Syntran 5170) which meets the limitations of instant claims 1(c) and 6-8. Additionally, the Examiner stated that adding film-forming agents such as PVP and PVP/VA copolymers is suggested by the disclosure. Further, the Examiner stated that example formulas in Bartholomey teaches to use waxes, glyceryl monostearate, water/ethanol solvents, black iron oxide, triglyceride, and preservatives and believes the weight ratio of glycerol monostearate to lecithin as required by instant claims 10-11 are also disclosed. Although the Examiner conceded that Bartholomey fails to teach the specific type of PVP copolymers in instant claim 1(b), the Examiner determined that Snyder teaches a waterproof mascara formulation comprising 1.5% of PVP tricontanyl copolymer. Therefore, the Examiner reasoned that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior art such as Snyder for specific types of the film-forming copolymers based on the general teaching of Bartholomey. Alternatively, the Examiner stated that the skilled artisan would have been motivated to modify the Bartholomey invention by adding PVP tricontanyl copolymer as suggested by Snyder because of the expectation of successfully producing waterproof mascara.

In the advisory action dated July 1, 2003, the Examiner opines that Appellants simply recognize another advantage to their invention which would flow naturally from following the suggestion of the prior art. The Examiner views that the mere absence of the explicit teaching of the physical characteristics of the prior art composition does not render a patentable distinction from the prior art to the present composition. The Examiner believes there is nothing in the record to indicate that the combination of the recited ingredients results in nonobvious or surprising results.

In view of the foregoing, the Examiner is of the opinion that the claimed invention is clearly obvious in view of the prior art.

For the reasons that will be set forth below, Appellants submit that Claims 1-4 and 6-25 are nonobvious over and patentably distinct from the cited references. Thus, the Board should reverse the Examiner's rejections. Accordingly, favorable action by the Board is respectfully requested.

I. Claims 1-4 and 6-25 are not obvious in view of the cited references under 35 USC §103(a) because the references fail to teach or suggest the necessity of the claimed amount of Appellants' specific PVP copolymers in combination with Appellants' claimed range of lecithin and resin that provides the benefits of aesthetic improvements and longevity.

Bartholomey discloses a composition which comprises from about 20% to about 65% solids; from about 20% to about 80% liquid vehicle; and from about 8% to about 50% a setting rate which delays the setting of the composition long enough to provide sufficient time to distribute the mascara in semi-liquid form onto the lashes as well as contribute to lash-thickening properties while avoiding negative aesthetics. Snyder discloses a cosmetic composition for lengthening, curling, and coloring human eyelashes comprising 10-25% of a gel composition and 75-90% of an oil in water emulsion base composition wherein when the gel composition is mixed into the base composition the water dissipatable polymer of the gel composition reacts with the oil soluble synthetic polymer of the base composition. The references, however, fail to teach or suggest each and every limitation of Appellants' claimed cosmetic composition that provides lash thickening, separation, and detangling in combination with long wear. Although Bartholomey generally discloses a PVP copolymer as an optional ingredient, it fails to teach the necessity of the claimed amount of Appellants' specific PVP copolymers in combination with Appellants' claimed range of lecithin and resin that provides the benefits of aesthetic improvements and longevity. The combination provided by Bartholomey fails to teach or suggest the particular formulation and particular ratios that chemically provides the aesthetic

attributes of the presently claimed invention, particularly the ability to detangle and separate lashes without sacrificing wear and lash thickening. Instead, Bartholomey discloses mascara compositions having improved *application characteristics* whereby the setting rate agent allows the mascara to remain in semi-liquid form in order to provide sufficient time for one to mechanically distribute the mascara onto the lashes in order to thicken the lashes and reduce clumping. Appellants respectfully submit that the novel ingredients and unique combination of elements in the present invention eliminates the ~~need~~ for such a setting rate agent. Rather than reliance on the novel chemical formulation unprecedented by Appellants' invention, the Bartholomey consumer must *physically* attempt to achieve the aesthetics of the present invention.

Since the features of Bartholomey are achieved by relying on the presence of a setting rate agent, there would be no motivation to combine the disclosure of Snyder to modify Bartholomey as suggested by the Examiner. Additionally, Snyder discloses the reaction of two film-forming polymers in order to provide lengthening properties. Such formulation may provide lengthening but would fall short of the other advantages, such as lash separation and anti-clumping, taught by Appellants' presently claimed invention. There is no teaching or suggestion of adding Appellants' PVP copolymer or lecithin in order to arrive at the aesthetically pleasing formulation of Appellants' invention. Appellants respectfully submit that it is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of Appellants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *See, SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. *In re Grabiak*, 222 USPQ2d 870, 872 (Fed. Cir. 1985). There is nothing in the prior art to suggest that the alleged prior inventors appreciated at the time of their work all the elements of the invention in order to combine the references and arrive at Appellants' presently claimed invention. Since there is no desire or motivation to combine Bartholomey and Snyder, the cosmetic composition of the present invention cannot be rendered as obvious. In light of the foregoing, Appellants respectfully request reconsideration and withdrawal of the rejection under 35 USC §103(a).

SUMMARY

Given the references' failure teach or suggest the necessity of the claimed amount of Appellants' specific PVP copolymers in combination with Appellants' claimed range of lecithin and resin that provides the benefits of aesthetic improvements and longevity, it would not have been obvious to a skilled artisan aware of the references to arrive at Appellants' presently claimed invention. Appellants respectfully submit that the Examiner's rejection of Claims 1-4 and 6-25 as being unpatentably obvious under 35 USC §103(a) is improper. Reversals by the Board of the Examiner's rejections are, therefore, respectfully requested.

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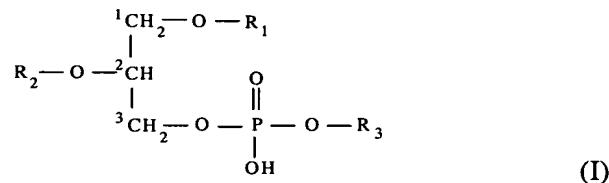
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APPENDIX I

Appealed Claims: Application No. 09/851,507

1. A cosmetic composition comprising:

a. from about 0.1% to about 5% of a phospholipid having the formula



in which R_1 represent C_{10-20} acyl, R_2 represent hydrogen or C_{10-20} acyl, R_3 represent hydrogen, 2-trimethylamino-1-ethyl, 2-amino-1-ethyl, C_{1-4} alkyl, C_{1-5} alkyl substituted by carboxy, C_{2-5} alkyl substituted by hydroxy, C_{2-5} alkyl substituted by carboxy and hydroxy or C_{2-5} alkyl substituted by carboxy and amino, the inositol group or the glycerol group, or salts of these compounds;

b. from about 0.1% to about 30%, by weight of the composition, of a PVP copolymer selected from the group consisting of tricontanyl PVP copolymer, PVP/hexadecane copolymer, and mixtures thereof; and

c. from about 0.1% to about 30%, by weight of the composition, of at least one resin.

2. The cosmetic composition of Claim 1 wherein the phospholipid is a naturally occurring phospholipid.

3. The cosmetic composition of Claim 2 wherein the phospholipid is lecithin.

4. The cosmetic composition of Claim 3 wherein, the lecithin is selected from the group consisting of oil-free lecithin, fractionated lecithin, and mixtures thereof wherein the lecithin has a phospholipid content of not less than 75% and with less than 5% free oil present.

5. (canceled)

6. The composition of Claim 1 wherein the resin is contained within a water insoluble latex.
7. The cosmetic composition of Claim 6 wherein the water insoluble latex is selected from the group consisting of acrylates copolymers, styrene/acrylates/methacrylate copolymer, acrylic latexes, styrene/acrylic ester copolymer latexes, polyvinylacetate latex, polyvinylacetate latex, polyvinylacetate latexes, vinyl acetate/ethylene copolymer latexes, styrene/butadiene copolymer latexes, styrene/butadiene copolymer latexes, polyurethane latexes, butadiene/acrylonitrile copolymer latexes, butadiene/acrylonitrile copolymer latexes, ammonium acrylates copolymer, styrene/acrylates/acrylonitrile copolymer latex, and mixtures thereof.
8. The cosmetic composition of Claim 7 wherein the water insoluble latex is an ammonium acrylates copolymer.
9. The cosmetic composition of Claim 1 further comprising a fat selected from the group consisting of glyceryl monostearate, glyceryl distearate, glyceryl tristearate, palmitate esters of glycerol, C18-36 triglycerides, glyceryl tribehenate, C18-36 acid triglycerides and mixtures thereof.
10. The cosmetic composition of Claim 9 wherein the mixture of the fat and phospholipid is at a level of at least 1% by weight of the composition, and the ratio of fat to phospholipid is from about 3:1 to about 12:1.
11. The cosmetic composition of Claim 10 wherein the mixture of the fat and phospholipid is at a level of at least 1% by weight of the composition, and wherein the ratio of fat to phospholipid is from about 3.5:1 to about 10.5:1
12. The cosmetic composition of Claim 1 wherein said composition further comprises a dermatologically acceptable carrier.

13. The cosmetic composition of Claim 12 wherein the carrier is a volatile carrier selected from the group consisting of water, lower alcohols, dihydric alcohols, polyols, hydroalcoholic mixtures, hydrocarbons, halogenated hydrocarbons, linalool, hydrocarbon esters, volatile silicones and mixtures thereof.
14. The cosmetic composition of claim 13 wherein the carrier is selected from the group consisting of water, ethyl alcohol, dihydric alcohols, polyols and mixtures thereof.
15. The cosmetic composition of claim 14 wherein the carrier is a mixture of water and ethyl alcohol and wherein the ratio of water to ethyl alcohol is from about 60:1 to about 4:1.
16. The cosmetic composition of Claim 1 that further comprises a wax.
17. The cosmetic composition of Claim 16 wherein the wax is selected from the group consisting of animal waxes, vegetable waxes, mineral waxes, various fractions of natural waxes, synthetic waxes, petroleum waxes, ethylenic polymers, Fischer-Tropsch waxes, silicone waxes, and mixtures thereof.
18. The cosmetic composition of Claim 17 wherein said wax is selected from the group consisting of beeswax, lanolin wax, carnauba, candelilla, ozokerite, ceresin, paraffins, microcrystalline waxes, polyethylene, C24-45 alkyl methicones, and mixtures thereof.
19. The cosmetic composition of Claim 1 that further comprises pigments selected from the group consisting of inorganic pigments, organic lake pigments, pearlescent pigments, and mixtures thereof.
20. The cosmetic composition of Claim 19 wherein the pigments are inorganic pigments selected from the group consisting of rutile titanium dioxide, anatase titanium dioxide, black iron oxide, yellow iron oxide, red iron oxide, manganese violet, ultramarine blue, chromium oxide, chromium hydrate, ferric blue, and mixtures thereof.

21. The cosmetic composition of Claim 20 wherein the pigments are surface-treated.
22. The cosmetic composition of Claim 1 that further comprises an emulsifier selected from the group consisting of soaps, phosphate esters, ethoxylated alcohols, ethoxylated fatty acids, ethoxylated fatty esters, polyol ether esters, glycerol esters, sucrose or sorbitan esters, glucose esters, potassium or DEA-cetyl phosphate, fatty esters and mixtures thereof.
23. The cosmetic composition of Claim 1 that is a mascara product that further comprises a component selected from the group consisting of cosmetic fillers, cosmetic preservatives, and mixtures thereof.
24. The cosmetic composition of Claim 1 that is in a product form suitable for application to keratinous tissue wherein said product form is selected from the group consisting of lipsticks, foundations, eyeliners, lipliners, eyeshadows, rouges, and combinations thereof.
25. The cosmetic composition of Claim 1 that is in a product form suitable for application to keratinous tissue wherein said product form is a mascara.